



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,396	01/16/2002	Denis Labrecque	108184-00017	3427
4372	7590	02/24/2003		
AREN'T FOX KINTNER PLOTKIN & KAHN 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER	
			SMALL, ANDREA D SOUZA	
		ART UNIT	PAPER NUMBER	
		1626		

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,396

Applicant(s)

LABRECQUE ET AL.

Examiner

Andrea D Small

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 31 December 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16, 18, 19, 22-34, 36, 37 and 40-75 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16, 18, 19, 22-34, 36, 37 and 40-75 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

6) Other: \_\_\_\_\_ .

## **DETAILED ACTION**

### ***I. Applicants Response:***

Applicants response filed 12/31/2002 has been received and entered as paper no. 7.

### ***II. Amendments:***

- (a) Cancelled claims: 17, 20, 21, 35, 38 and 39.
- (b) Pending claims: 1-16, 18-19, 22-34, 36-37 and 40-75.
- (c) Amended claims: 1, 4, 6, 16, 27-34, .3-37, 40-41 and 74-75.

### ***III. Remarks:***

- (a) Rejection under 35 USC 112, first ('how to make'): Applicants have amended claims 1 and 27 to recite "the valences of each O, N, or S are adjusted by adding a H if needed" to attempt to overcome the lack of written description, specifically, the how to make requirement.

Applicants have also traversed the rejection arguing that "[I]t would be apparent to a person skilled in the art that the valences on the O, S and N atoms were really not dangling because the person would have known that the O, S and N atoms must fulfill the valence requirements in chemistry, thus if needed a H atom is attached to the O, S and N atom according to valence requirements."

The examiner respectfully disagrees. Although a person of ordinary skill would know that the valence requirements would have to be fulfilled, a person of ordinary skill would not know after reading the instant specification or claims that a H atom would fulfill the valence requirement in the instant case. There is no descriptive support in the specification or in the originally filed claims to show how to make compounds that have a H atom at the dangling valence part of the molecule. Further, in the chemical arts, numerous atoms and molecules

Art Unit: 1626

would satisfy the valence requirement for O, S or N. For instance, an oxygen or sulfur atoms could be fulfilled by a H atom, a CH<sub>3</sub> moiety, a CH<sub>2</sub>CH<sub>3</sub> moiety, a CH<sub>2</sub>CH<sub>2</sub>CH<sub>3</sub> moiety, etc...the nitrogen valence could be fulfilled by any number of atoms or molecules, which could include heterocyclic and carbocyclic moieties, protective groups, etc. The Applicant has not provided any descriptive support to show an ordinary skilled artisan with the knowledge of how to make compounds that would have any of these possible valence fulfilling atoms or molecules. Therefore, the instant claims still lack written description as the specification does not teach one of ordinary skill in the art how to make the instantly claimed compounds.

(b) Rejection under 35 USC 112, second:

(i) The rejection as to the word "comprising" has been overcome by the amendment to claims recite the phrase "selected from the group consisting of".

(ii) The amendment to claims 1 and 27 has not overcome the indefiniteness rejections as to the dangling valence, see rejection below.

(c) Rejection under 35 USC 112, second: upon reconsideration, the rejection as to the indefiniteness of claims 74 and 75 has been withdrawn.

(d) Objections: The cancellation of non-elected subject matter in claims 1-16, 18-19, 22-34, 26-27 and 40-75 and claims 17, 20, 21, 35, 38 and 39 has overcome the objections.

***IV. Maintained Rejections:***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1626

(a) Claims 1-16, 18-19, 22-34, 36-37 and 40-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 27 have incomplete molecules due to the dangling valences found on the molecules, the divalent nitrogen, the monovalent oxygen, and when G2 is a non-heterocycle, the divalent nitrogen or the monovalent oxygen or sulfur on the molecule. The "how to make" requirement of 35 USC §112, first paragraph has not been met as the application offers no method for preparing an incomplete molecule or molecules substituted by H atom as now recited in claims 1 and 27 to complete the dangling valences.

Support is seen only for the specific compounds of the elected area in the examples which are, examples VII, VIII, IX, X, XI, XVIII, XIX, XXI, and XXX.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(a) Claims 1-16, 18-19, 22-34, 36-37 and 40-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 27 have incomplete molecules due to the dangling valences found on the molecules, the divalent nitrogen, the monovalent oxygen, and when G2 is a non-heterocycle, the divalent nitrogen or the monovalent oxygen or sulfur on the molecule. The above molecule is incomplete and thereby allows for varying possibilities of substituents to be attached on the molecule. The amendment to claims 1 and 27 requiring "the valences of each O, N, or S are adjusted by adding a H if needed" introduces further

Art Unit: 1626

indefiniteness to the claims as the amendment lacks antecedent basis in the specification and does not provide any standard for ascertaining when the need would arise for a hydrogen atom to be substituted on the molecule. The specification does not provide any guidance for ascertaining the possible substituents contemplated and one of ordinary skill in the art would not be appraised as to the metes and bounds of the instant claims.

***V. New Rejections:***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16, 18-19, 22-34, 36-37 and 40-75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have amended claims 1 and 27 to recite "the valences of each O, N, or S are adjusted by adding a H if needed" to attempt to overcome the lack of written description, specifically, the how to make requirement. This phrase does not have any support in the specification or the claims. The two examples on page 52 and the knowledge generally available to an ordinary skilled artisan, do not overcome the fact that there are many means by which the molecules claimed in claims 1 and 27 can have their valences fulfilled, none of which are contained or described in the original disclosure. Consequently, the addition of a new structural formula in claims 1 and 27 by adding the phrase,

Art Unit: 1626

"the valences of each O, N, or S are adjusted by adding a H if needed" is determined to be new matter. See *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16, 18-19, 22-34, 36-37 and 40-75 are rejected under 35 U.S.C. 112, , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendment "the valences of each O, N, or S are adjusted by adding a H if needed." added to claims 1 and 27 lacks antecedent basis in the specification and as such renders the claims 1 and 27 and those claims that depend from said claims indefinite.

***VI. New Objections:***

The amendment filed 12/31/2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the valences of each O, N, or S are adjusted by adding a H if needed." in claims 1 and 27.

Applicant is required to cancel the new matter in the reply to this Office Action.

***VII. Finality:***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***VIII. Salutation:***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
February 14, 2003

Joseph K. McKane  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Technology Center 1